REMARKS

Claims 1-37 of the subject application are currently pending, and have been rejected by the Examiner.

In the accompanying amendment, the Applicants have amended claims 1, 12, 13, 18, and 30. Support for the amendments to the claims can be found in the written description, drawings, and claims of the application, as originally filed. Accordingly, it is respectfully submitted that the amendments to the claims do not add new matter.

Claims 1, 2, 4-20, 22-31, and 33-37 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Etesse et al (U.S. PG Pub. 2004/0030781).

The Applicants traverse the Examiner's rejection of the claims under 35 U.S.C. § 102(e) on the following grounds:

(1) <u>The Examiner has failed to show that Etesse is prior art under 35 U.S.C. § 102(e)</u>:

Etesse is a published application, but not a granted patent. Etesse was published on February 12, 2004 which is after the date of filing of the subject application on 22 January 2001. However, Etesse claims the priority benefit of application no. 09/608,208 (hereinafter "the '208 application"), which was filed on June 30, 2000.

In order to carry back the 35 U.S.C. § 102(e) critical date of a U.S. patent application publication reference to the filing date of a parent application, the application must (A) have a right of priority to the earlier date under 35 U.S.C. § 120, and (B) support the invention claimed as required by 35 U.S.C. § 112, first paragraph.

In order for a later filed application for an invention to enjoy the benefit of the earlier filing date of a previously filed application in the United States, 35 U.S.C. § 120 requires the previously filed application to disclose the invention in the manner provided for by the first paragraph of U.S.C. § 112. Since Etesse is a continuation-in-part application based on the '208 application, before the Examiner carries back the 35 U.S.C. § 102(e) critical date of Etesse, the

Examiner has to show that Etesse enjoys the right of priority to the '208 application under 35 U.S.C. § 120. Save for pointing out that Etesse is a continuation-in-part application based on the '208 application, the Examiner has not provided any analysis to show that the '208 application supports the invention claimed under U.S.C. § 112, first paragraph. Further, the Examiner has also failed to show that the Etesse reference itself supports the invention claimed as required by 35 U.S.C. § 112, first paragraph. In this regard, the Examiner is reminded that since Etesse is not a granted patent, the presumption of validity under 35 U.S.C. § 282 does not apply. Thus, the Examiner bears the burden of showing that Etesse supports the invention claimed as required by 35 U.S.C. § 112, first paragraph.

(2) Etesse does not teach or suggest all limitations of the invention as claimed:

For example, claim 1 includes the following limitation:

> "receiving a web page, wherein the web page includes a plurality of data elements and wherein each one of the plurality of data elements is at least one of a plurality of known data types;
>
> classifying each one of the plurality of data elements as one or more of the data types;
>
> determining a plurality of related operations for each one of the plurality of classified data elements ; and
>
> outputting the plurality of related operations."
> (Claim 1)

With regard to claim 1, the Examiner has stated that:

> "Etesse teaches "classifying... elements" (i.e., course listed according to category) (para 147).
>
> Etesse teaches "determining... data elements" (i.e., course content - lists everything related to a course) (para 149, 150; Fig. 7, 9 Item 900).
>
> Etesse teaches "outputting... operations" (i.e., course content... browser) (para 149; Fig. 7, Item 900)"
> (Office Action, Page 2)

Based on the above, it appears that the Examiner believes that Etesse teaches the limitation of "classifying each one of the plurality of data elements..." because, a user may select

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the "courses" tab 502, which links the user to a course page 600 (see Fig. 6), which provides direct links to the courses that a user teaches or is enrolled in (see para 147). In response, Applicants argue that the ability of the system disclosed in Etesse to allow a user to be linked to a course page, as described above is <u>not</u> the same as the limitation of "classifying each one of the plurality of data elements...", as recited in claim 1. The "classifying..." limitation of claim 1 requires that data elements be classified into data types. For example, in a travel planning web page, there may be various data types such as origin, destination, dates, airline, rental car company, hotel, locations of various airports, hotels, parts of speech (e.g., noun, verb, article, etc.), persons, place, time, date, address, phone book, etc. According to the "classifying..." limitation of claim 1, the data elements in the travel planning web page would be classified into one or more of the above data types. In Etesse, no classification into data types is performed. In Etesse a browser merely receives a web page and displays the web page in accordance with the instructions contained in the web page.

Further, the "determining..." limitation of claim 1 is not taught or suggested by Etesse. In this regard, the Examiner's argument that this limitation is taught by Etesse, because Etesse teaches listing everything <u>related</u> to a course, is incorrect. Consider that the relationship between a course and a listing of everything related to the course is through a link in a web page: This relationship is a one-to-one relationship. In other words if the course is selected in a first web page, the listing of everything related to the course is displayed. It is <u>not</u> possible to select the course in the first web page and to be linked to a second web page that does something other than of listing everything related to the course. In contrast, for example, a related operation for the "destination" data type described on page 19, lines 5-10 may include any of the following:

a look up of weather in the destination;

a look up of hotels and/or restaurants in the destination;

a look up of hotel and/or restaurant views in the destination, etc.

Thus, the "determining..." limitation of claim 1, requires that for each classified data element <u>a plurality</u> of related operations is determined. Moreover, as previously argued, Etesse does not teach or suggest the concept of a "data element".

Further, Etesse does not teach or suggest the "outputting a plurality of related operations" limitation of claim 1. Again, even if, for the sake of argument, the "course content" is assumed to be a data type, and the list of everything relating to a particular course is assumed to be a related operation, it will be seen that Etesse does not teach or suggest the "outputting..." limitation of claim 1 because when the user clicks or selects the course content, the user is linked through to the list of everything relating to a course (Item 900 in Fig. 9). In other words only one "related operation" i.e. the listing 900 is output, instead of a <u>plurality of related operations</u> required by the "outputting..." limitation of claim 1.

Based on the foregoing, it is respectfully submitted that Etesse does not teach or suggest all limitations of claim 1, and accordingly cannot anticipate claim 1.

Given that claims 2-11 depend on claim 1, it is respectfully submitted that these claims are also not anticipated by Etesse.

Independent claims 12, 13, 18, and 30 include limitations similar in scope to the above discussed limitations of claim 1. Accordingly, it is respectfully submitted that Etesse does not anticipate claims 12, 13, 18, and 30. Further, the remaining claims of the subject application are dependent on one of claims 12, 13, 18, and 30, and accordingly it is respectfully submitted that these remaining claims are also not anticipated by Etesse.

<center>Double Patenting Rejection</center>

A telephone conversation was held between Applicant's representative and the Examiner's supervisor on June 7, 2004, to discuss the provisional statutory double-patenting rejection. From that telephone call, Applicant understands that the provisional statutory double-patenting rejection will be held in abeyance until the present application is otherwise deemed to be in condition for allowance, since the status or claims of the cited patent application may

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change. For the same reason, Applicant respectfully requests that the Examiner re-assess that rejection in response to this submission.

Authorization is hereby given to charge our Deposit Account 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such an extension.
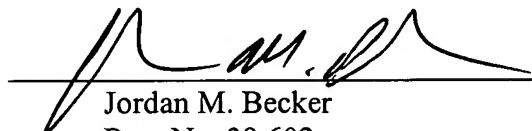
In view of the amendments, and the remarks set forth herein, it is respectfully submitted that the claims are now in condition for allowance, which action is earnestly solicited.

It is respectfully submitted that in view of the amendments and remarks set forth herein, all rejections have been overcome. All pending claims are now in condition for allowance, which is earnestly solicited.

Respectfully submitted,

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Dated: 8/12/04

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